03-15-06

2614

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Jeng Jye Shau	:	Date: March 13, 2006
Serial No.:	09/539,309	:	Group No.: 2614
Filed:	March 30, 2000	:	Examiner: Jean Wicel Desir
Attorney Docket No.: Shau-2K01		:	@(650)858-2052(T) 858-2326(F)

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this Proposal for Office Response Transmittal and the documents referred to as enclosed therein are being deposited with the United States Postal Service on this date March 13, 2006 in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington, D. C. 20231.

Jeng-Jye Shau
(Printed name of person mailing papers)

(Signature of person mailing papers)

NOTE: Each paper or fee referred to as enclosed herein has the number of the "Express Mail" mailing label placed thereon to mailing. 37 CFR 1.10(b).

To the Commissioner of Patents and Trademarks:

Reply to Office Communication

Dear Sir:

In response to the Office communication mailed on March 3, 2006, signed by Mr. David Ometz, and based on the telephone communication between Mr. Ometz and the Applicant on March 10, 2006, the Applicant hereby respectfully requests reconsideration of the application for reasons as set forth below.

October 31, 2005

Patent application 09/539,309 has an unusually complex history. In the first official response mail on 11/22/2002, the first examiner Mr. Linus Lo objected to but allowed 4 claims (34-37). On 8/11/2003, the second examiner Mr. David Harvey requested election of claims. At that time, the Applicant wanted to respect the decisions of both Mr. Lo and Mr. Harvey by electing one of the allowed claims (claim 35). For unknown reason, a mistake happened and claims related to video game application were elected instead. Multiple mistakes and delays happened after that, wasting huge amount of resources and causing long delays. The Applicant took over the processing in 2005, and tried to revive the patent.

On 10/06/2005, Mr. Jean Wicel Desir replaced Mr. David Harvey as the third examiner of patent application. The Applicant respectfully contacted Mr. Desir multiple times through telephone discussions. The Applicant explained that the election of the video game claims was a mistake and proposed to examine one of the allowed claims. The Applicant respectfully collected advices from Mr. Desir, wishing to make sure my response would be considered reasonable before the response was mailed on 10/20/2005. The Applicant sincerely tried my best efforts to communicate and to response while respecting the decisions of all three examiners (Mr. Lo, Mr. Harvey, and Mr. Desir).

Unfortunately, the communication was not perfect. The Applicant did not realize the need to communicate with Mr. Desir that the elected original claim 35 was not related to video game. The Applicant understands the point in the office communication letter mailed on 3/3/2006, but continuing treating the patent as video game application will not yield any meaningful results, as the Applicant explained to Mr. Desir and Mr. Ometz in our telephone communications.

The patent application 09/539,309 disclosed methods and structures for transferring digital data using television video signal. Video game application is nothing but a small example in the specification. Treating this patent as video game application is against the intention of the Applicant and it is incorrect considering the contents of the specifications. It was a mistake. The video game claims are at most dependent claims useful only as examples. Continuing to treat this patent application as video game application is a waste of resource for both PTO and the Applicant. All the efforts will be wasted because the Applicant won't be able to implement the patent even if it is allowed.

The Applicant sincerely wanted that the resource spent by PTO and the Applicant can yield practical products to improve human life. That is the true intentions of patent laws and patent office. As the Applicant discussed with Mr. Ometz and Mr. Desir in our telephone discussions, the only way to achieve meaningful results is to process the claims based on the originally allowed claim 35. The Applicant also believes this action will not cause troubles to PTO because thorough searches had been done by the first examiner Mr. Lo on the elected claim. The submitted claims 49-58 are structure and method claims based on originally allowed claim 35 while following the suggestions from Mr. Desir to write them in clearer languages.

The Applicant is advised that re-election of claim is a commonly allowed practice, and it is a right of the inventor before the official action is made final. However, the key point is to produce constructive results out of all the resources spent on this case. The proposed action meets the requirements from all three examiners and matches the intention of the inventor. The Applicant will try my best to communicate with PTO to follow your advices to achieve the purpose of making practical products out of all the efforts spent on patent application 09/539,309. Please feel

free to contact me for further advices. The Applicant will respectfully contact Mr. Desir and Mr. Ometz for your advices.

Respectfully submitted

By Jeng Jye Shau

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October 31, 2005